REMARKS

In response to the Office Action of May 27, 2005, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-23 are pending in this application. By this Amendment, Claim 5 has been amended to conform the language to Claim 1 from which it depends and Claim 21 has been amended to depend on Claim 20. Applicants respectfully submit that no new matter has been added to this application. Moreover, it is believed that the claims as presented herein places the application in condition for allowance.

The Examiner has objected to the specification for certain informalities, namely, including the serial number and filing date of the referenced patent application on page 19. The specification has been amended in a manner believed to obviate the Examiner's objection. Accordingly, withdrawal of the objection is respectfully requested.

The Examiner has objected to Claim 21 for the recitation "the means for measuring deposit formation" as lacking antecedent basis. Claim 21 has been amended in a manner believed to obviate the Examiner's objection. Accordingly, withdrawal of the objection is respectfully requested.

The Examiner has provisionally rejected Claims 1-3, 6, 11, 12, 15-18 and 21-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-5, 17, 18 and 24-30 of co-pending Application No. 10/779,422. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1-3 and 10-14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 20, 22-24 and 26-30 of co-pending Application No. 10/699,529. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1, 3, 10-18, 22 and 23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 2, 13-17, 20, 22, 34-37, 39-42, 44 and 45 of co-pending Application No. 10/699,507. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1, 3, 15, 17 and 22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 13, 19-22 and 33-35 of co-pending Application No. 10/699,509. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has rejected Claims 1-6 and 15-19 under 35 U.S.C. §103 (a) as being obvious over Kolosov et al. U.S. Patent Application Publication No. 2004/0123650 ("Kolosov") in view of O'Rear U.S. Patent Application Publication No. 2003/0100453 ("O'Rear") or Gatto et al. U.S. Patent Application Publication No. 2003/0171226 ("Gatto").

As acknowledged by the Examiner, nowhere does Kolosov disclose or suggest a high throughput method for screening lubricating oil compositions, under program control, comprising (a) providing a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) measuring the oxidation stability of each sample to provide oxidation stability data for each sample; and, (c) outputting the results of step (b) as presently recited in Claim 1. Nor, as also acknowledged by the Examiner, does Kolosov disclose or suggest a system for screening lubricating oil composition samples, under program control, comprising (a) a plurality of test receptacles, each containing a different lubricating oil composition sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) a computer controller for selecting individual samples for testing; (c) receptacle moving means responsive to instructions from the computer controller for individually moving the selected samples to a testing station for measuring oxidation stability of the selected samples; (d) means for measuring the oxidation stability of the selected samples to obtain oxidation stability data and for transferring the oxidation stability data to the computer controller as presently recited in Claim 15.

Rather, Kolosov discloses a system and method for screening a library of a multitude of genera of material samples for rheological properties. The genera of material disclosed in Kolosov which can be tested include polymeric materials, organic materials, amorphous materials, crystalline materials, macromolecular materials, small-molecule materials, inorganic materials, pure materials, mixtures of the materials, any commercial product itself or an ingredient or portion within a commercial product such as pharmaceuticals, coatings, cosmetics, adhesives, inks, foods, crop agents, detergents, protective agents, and lubricants, as well as gels, oils, solvents, greases, creams, foams and other whipped materials, ointments, pastes, powders, films, particles, bulk materials, dispersions, suspensions, and emulsions.

In addition to testing the rheological properties of the broad categories of flowable material, Kolosov discloses that other properties may be tested and includes a large number of broad tests such as density, melt index, thermal degradation, aging characteristics, weight-average molecular weight, number-average molecular weight, viscosity-average molecular weight, peak molecular weight, approximate molecular weight, polydispersity index, molecular-weight-distribution shape, relative or absolute component concentration, conversion, concentration, mass, hydrodynamic radius, radius of gyration, chemical composition, amounts of residual monomer, presence and amounts of other low-molecular weight impurities in samples, particle or molecular size, intrinsic viscosity, molecular shape, molecular conformation, and/or agglomeration or assemblage of molecules. According to Kolosov, any of the genera of flowable material can be subjected to any of the plurality of tests disclosed.

However, at no point is there any appreciation in Kolosov of screening lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, under program control, by measuring the oxidation stability of each sample to provide oxidation stability data; and outputting the results. Thus, nothing in Kolosov would lead one skilled in the art to modify the system and method for testing the genera of flowable material with any of the broad tests disclosed therein and arrive at the specifically recited high throughput method for screening lubricating oil composition samples, under program control, comprising (a) providing a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) maintaining each sample at a predetermined temperature for a predetermined time; (c) measuring the storage stability of each sample to provide storage stability data for each sample; and, (d) outputting the results of step (c) as presently recited in Claim 1. Also, nothing in Kolosov would lead one skilled in the art to modify the system and method for testing the genera of flowable material with any of the broad tests disclosed therein and arrive at the specifically recited system for screening lubricating oil composition samples, under program control, comprising (a) a plurality of test receptacles, each containing a different lubricating oil composition sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) a computer controller for selecting individual samples for testing; (c) receptacle moving means responsive to instructions from the computer controller for individually moving the selected samples to a testing station for measuring oxidation stability of

the selected samples; (d) means for measuring the oxidation stability of the selected samples to obtain oxidation stability data and for transferring the oxidation stability data to the computer controller as presently recited in Claim 15.

O'Rear fails to cure the deficiencies of Kolosov. Specifically, nowhere does O'Rear disclose a high throughput method for screening lubricating oil composition samples comprising (a) providing a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) measuring the oxidation stability of each sample to provide oxidation stability data for each sample; and, (c) outputting the results of step (b) as presently recited in Claim 1. Nor does O'Rear disclose or suggest a system for screening lubricating oil composition samples, under program control, comprising (a) a plurality of test receptacles, each containing a different lubricating oil composition sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) a computer controller for selecting individual samples for testing; (c) receptacle moving means responsive to instructions from the computer controller for individually moving the selected samples to a testing station for measuring oxidation stability of the selected samples; (d) means for measuring the oxidation stability of the selected samples to obtain oxidation stability data and for transferring the oxidation stability data to the computer controller as presently recited in Claim 15.

Rather, O'Rear discloses a blend of synthetic and non-synthetic lube base oils wherein the lube base oil product has a greater stability in the absence of additives than the stability of the synthetic lube base oil and has a greater stability in the presence of additives than the non-synthetic lube base oil. O'Rear further discloses that the blend of lube base oils may or may not contain one or more additives. It is not seen where in O'Rear there is any suggestion, motivation or even a hint of a high throughput method and system for screening a plurality of lubricating oil composition samples, under program control, by measuring the oxidation stability of each sample and outputting the results. Instead, O'Rear is merely concerned with forming a blend of lube base oils wherein the lube base oil product has a greater stability in the absence of additives than the stability of the synthetic lube base oil and has a greater stability in the presence of additives than the non-synthetic lube base oil. Thus, nothing in O'Rear would lead one skilled in the art to modify the system and method of Kolosov by looking to the disclosure of O'Rear and arrive at the claimed high throughput method and system for screening lubricating oil composition samples, under program control, by measuring the oxidation stability of each sample and outputting the results.

Gatto fails to cure the foregoing deficiencies of Kolosov. Specifically, nowhere does Gatto disclose a high throughput method for screening lubricating oil composition samples comprising (a) providing a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) measuring the oxidation stability of each sample to provide oxidation stability data for each sample; and, (c) outputting the results of step (b) as presently recited in Claim 1.

Nor does Gatto disclose or suggest a system for screening lubricating oil composition samples, under program control, comprising (a) a plurality of test receptacles, each containing a different lubricating oil composition sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) a computer controller for selecting individual samples for testing; (c) receptacle moving means responsive to instructions from the computer controller for individually moving the selected samples to a testing station for measuring oxidation stability of the selected samples; (d) means for measuring the oxidation stability of the selected samples to obtain oxidation stability data and for transferring the oxidation stability data to the computer controller as presently recited in Claim 15.

Rather, Gatto discloses organomolybdenum compositions useful as lubricant additives. Gatto further discloses testing the organomolybdenum compositions in a base oil using the Caterpillar Micro-Oxidation test. However, it is not seen where in Gatto there is any suggestion, motivation or even a hint of a high throughput method and system for screening a plurality of lubricating oil composition samples, under program control, by measuring the oxidation stability of each sample and outputting the results. Instead, Gatto is merely concerned with organomolybdenum compositions that solve the problems of a previously unfulfilled need in the lubricant additive and composition industry and related technologies for oil soluble, sulfur-free molybdenum additives having high molybdenum content and low tendency to discolor finished oils without the need to use volatile solvents and without the need to remove non-reacted molybdenum. Thus, nothing in Gatto would lead one skilled in the art to modify the system and method of Kolosov by looking to the disclosure of Gatto and arrive at the claimed high

throughput method and system for screening lubricating oil composition, under program control, by measuring the oxidation stability of each sample and outputting the results.

For the foregoing reasons, Claims 1-6 and 15-19 are believed to be nonobvious, and therefore patentable, over Kolosov and O'Rear or Gatto.

The Examiner has rejected Claim 9 under 35 U.S.C. §103 (a) as being obvious over Kolosov in view of Perez et al. U.S. Patent No. 5,236,610 ("Perez").

The foregoing deficiencies of Kolosov discussed above with respect to the rejection of Claim 1, from which Claim 9 depends, apply with equal force to this rejection. Perez does not cure the above-noted deficiencies of Kolosov. Rather, Perez discloses stable high temperature liquid lubricant blends and antioxidant additives. Perez further discloses two differential scanning calorimetry methods for studying oxidation stability. However, it is not seen where in Perez there is any suggestion, motivation or even a hint of a high throughput method and system for screening a plurality of lubricating oil composition samples, under program control, by measuring the oxidation stability of each sample and outputting the results. Instead, Perez is merely concerned with providing an antioxidant additive for lubricants which has a relatively low volatility at high temperatures and minimizes oxidation and the formation of harmful deposits. Nothing in Perez would lead one skilled in the art to modify the system and method of Kolosov by looking to the disclosure of Perez and arrive at the claimed high throughput method and system for screening lubricating oil composition, under program control, by measuring the oxidation stability of each sample by differential scanning calorimetry and outputting the results, as recited in present Claim 9.

For the foregoing reasons, Claim 9 is believed to be nonobvious, and therefore patentable, over Kolosov and Perez.

The Examiner has rejected Claims 7, 8, 20 and 21 under 35 U.S.C. §103 (a) as being obvious over Kolosov in view of O'Rear or Gatto and further in view of McFarland et al. U.S. Patent No. 6,541,271 ("McFarland").

The foregoing deficiencies of Kolosov, O'Rear and Gatto discussed above with respect to the rejections of Claims 1 and 15, from which Claims 7, 8, 20 and 21 ultimately depend, apply with equal force to this rejection. McFarland does not cure the above-noted deficiencies of Kolosov, O'Rear and Gatto. Rather, McFarland merely discloses a method and apparatus for characterizing liquids, dissolved organic or inorganic molecules, covalent network solids, ionic solids and molecular solids utilizing thermal imaging and infrared spectroscopic imaging. However, it is not seen where in McFarland there is any suggestion, motivation or even a hint of a high throughput method and system for screening a plurality of lubricating oil composition samples, under program control, by measuring the oxidation stability of each sample and outputting the results. Thus, nothing in McFarland would lead one skilled in the art to modify the system and method of Kolosov in view of O'Rear or Gatto by looking to the disclosure of McFarland and arrive at the claimed high throughput method and system for screening lubricating oil composition, under program control, by measuring the oxidation stability of each sample and outputting the results.

For the foregoing reasons, Claims 7, 8, 20 and 21 are believed to be nonobvious, and therefore patentable, over Kolosov, O'Rear, Gatto and McFarland.

The Examiner has rejected Claims 11-14 under 35 U.S.C. §103 (a) as being obvious over Kolosov in view of O'Rear or Gatto and further in view of Smrcka et al. European Patent Application No. 1,233,361 ("Smrcka").

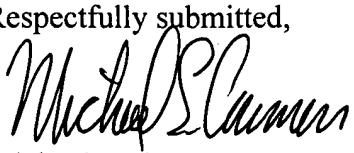
The foregoing deficiencies of Kolosov, O'Rear and Gatto discussed above with respect to the rejections of Claim 1, from which Claims 11-14 ultimately depend, apply with equal force to this rejection. Smrcka does not cure and is not cited as curing the above-noted deficiencies of Kolosov, O'Rear or Gatto. Rather, Smrcka is merely cited for its disclosure of storing test results in a data carrier. Accordingly, Claims 11-14 are believed to be nonobvious, and therefore patentable, over Kolosov, O'Rear, Gatto and Smrcka.

The Examiner has rejected Claims 22 and 23 under 35 U.S.C. §103 (a) as being obvious over Kolosov in view of O'Rear or Gatto and further in view of Garr et al. U.S. Patent No. 5,993,662 ("Garr").

The foregoing deficiencies of Kolosov, O'Rear and Gatto discussed above with respect to the rejections of Claim 15, from which Claims 22 and 23 ultimately depend, apply with equal force to this rejection. Garr does not cure and is not cited as curing the above-noted deficiencies of Kolosov, O'Rear or Gatto. Rather Garr is simply cited for the disclosure of employing a bar code to identify individual containers. Accordingly, Claims 22 and 23 are believed to be nonobvious, and therefore patentable, over Kolosov, O'Rear, Gatto and Garr.

For the foregoing reasons, Claims 1-23 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



Michael E. Carmen
Reg. No. 43,533
Attorney for Applicants

DILWORTH & BARRESE
333 Earle Ovington Blvd.
Uniondale, NY 11553
(516) 228-8484
MEC:bg